REMARKS/ARGUMENTS

Restriction Requirement

The Office Action sets forth a restriction requirement between the following groups of claims:

(I) claims 42-93 (drawn to fused ring compounds);

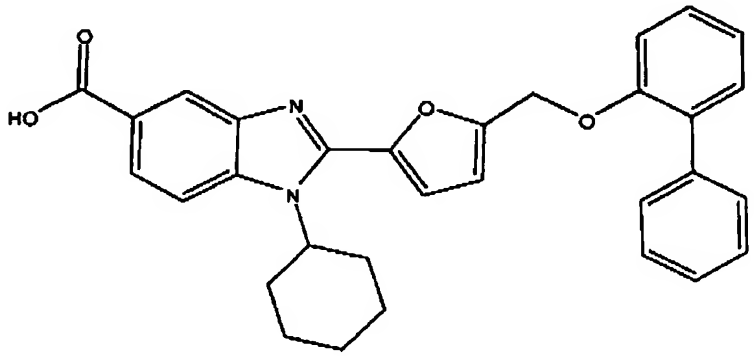
(II) claims 1-41, 94-101, and 103-110 (drawn to therapeutic agents for hepatitis C, pharmaceutical compositions, methods of inhibiting hepatitis C polymerase, and methods of treating hepatitis C comprising the compounds set forth in Group I); and

(III) claim 102 (drawn to two thiazole compounds).

The Office Action also sets forth a species selection requirement.

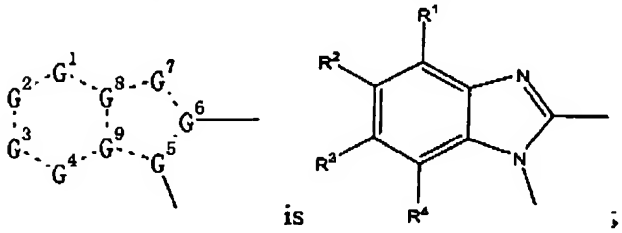
Applicants' Election

Applicants elect, with traverse, the claims of Group I (i.e., claims 42-93) for examination. In addition, Applicants elect the following specie:



2-[2-(2-biphenylyloxymethyl)-5-furyl]-1-cyclohexylbenzimidazole-5-carboxylic acid,

which is supported by the specification at, for example, Example 253 on page 75, lines 23-24. The elected specie has the following substituents in accordance with formula II:



is ;

R^1, R^3, and R^4 are hydrogen;

R^2 is $-CO_2H$;

ring Cy′ is cyclohexyl;

ring A′ is furyl;

$R^{5'}$ and $R^{6'}$ are hydrogen;

Y is $-(CH_2)_m-O-(CH_2)_n-$;

m is 1;

n is 0;

B is phenyl;

Z is phenyl; and

w is 1.

Elected claims 42, 44, 47-51, 53, 54, 60-62, 74, 76, 79-83, 87-89, and 91 (and non-elected claims 1-6, 8, 11, 12, 15, 29-34, 36, 39, 40, 94-101, and 103-110) read on the elected specie. Reconsideration of the requirement for restriction is respectfully requested.

Discussion of the Restriction Requirement

Groups I and II allegedly are unrelated because the claims are drawn to a product and process of using the product. According to the Office, distinctiveness can be shown for claims with this type of relationship if the process can be practiced with a materially different product or the product can be used in a materially different process. Groups I and III allegedly are unrelated because the claims are drawn to products that are not disclosed as capable of use together and/or have different designs, modes of operations, or effect. Applicants respectfully submit that the restriction requirement is improper for the reasons set forth herein and, therefore, request withdrawal, in part, of the restriction requirement.

The Manual of Patent Examining Procedure (M.P.E.P.) recites the requirements for a proper restriction requirement. In particular, the M.P.E.P. states that there are two criteria for proper restriction between patentably distinct inventions: (a) the inventions must be independent, *and* (b) there must be a serious burden on the examiner in the absence of restriction. See M.P.E.P. § 803. These are two separate criteria that must be satisfied to support a proper restriction requirement. The fact that both criteria must be satisfied is made all the more clear by the following statement in the M.P.E.P.: "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (emphasis added). Thus, if the subject matter of the pending claims is such that there would be no serious burden on the Examiner to search and examine all of the pending claims at the same time, the Examiner is to do so, *even if* the pending claims are drawn to independent or distinct inventions.

Applicants respectfully submit that the restriction requirement as between the claims of Groups I and II is improper because the nature of the claims is such that any burden encountered in searching the groups together would, at most, be slight (and certainly not "serious"). In this respect, the claims of Group I (claims 42-93) are directed to a compound of formula II. The claims of Group II (claims 1-41, 94-101, and 103-110) are directed to a compound of formula I, a pharmaceutical composition comprising a compound of formula I or II, and a method of using the compound of formula I. The compound of formula II (i.e., Group I) is a sub-genus of a compound of formula I (i.e., Group II), and therefore encompass the same core structure. As such, any search and consideration of the claimed subject matter of Group I will necessarily overlap the search and consideration of the claimed subject matter of Group II.

Accordingly, there would appear to be sufficient similarity between the claims of Groups I and II to allow for the search and examination of the subject matter of claims 1-101 and 103-110 at the same time without a "serious burden" being placed on the Examiner. Applicants, therefore, respectfully request partial withdrawal of the restriction requirement, and respectfully submit that the claims of Groups I and II should be examined together. If, however, the restriction requirement is not withdrawn, the Examiner has indicated that some of the claims of Group II (i.e., pharmaceutical composition and method of use claims) can be

rejoined for examination upon an indication of allowable subject matter and to the extent the claims of Group II are drawn to a pharmaceutical composition or method of using a compound of formula II as recited in an allowed claim of elected Group I.

Conclusion

For the foregoing reasons, Applicants respectfully request the partial withdrawal of the restriction requirement and examination of claims 1-101 and 103-110 at this time. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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